

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claims 7-8 have been cancelled. Claim 1 has been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner rejected Claims 1-3 and 6 under 35 U.S.C. §103(a) as being unpatentable over Bolte U.S. Patent No. 3,584,776 (Bolte), in view of Gschwend et al., U.S. Patent No. 5,181,495 (Gschwend). Claims 4-5 and 7-8 were rejected as Claims above and further in view of Averbukh, U.S. Patent No. 5,497,555 (Averbukh) and Bade, U.S. Patent No. 3,320,860 (Bade), respectively. It is respectfully submitted that claims 1-6 are patentably over the cited references.

Specifically, claim 1 recites a spacer (33) formed as a shock-absorbing element and provided between the magnetic piston-retaining means and the drive piston. No such shock-absorbing element is disclosed in the prior art, including all of the prior art of record in their application.

Considering the prior art, Bade discloses a staple driving apparatus driven by compressed air that has magnets (22) arranged in an insert (14) at one end of cylinder (12). In the same area of the insert that houses the magnets (22) cushioning members (22a) are arranged in a distance to the magnets (22). These members are not arranged between the magnets and the piston. Further Bade discloses (column 5, lines 40 – 44) that the piston “abuts the magnet 22 and cushioning-member or members 22a in insert 14”. This means that there is no effect of protecting the magnets associated with the cushioning members (22a).

According to a dictionary definition (the American Heritage College Dictionary, Houghton Mifflin Co., 2002), “between” means “In . . . the interval separating “(1a), In an intermediate space . . .” (6) (page 136, right column). Clearly in Bade, the cushioning numbers (22a) do not separate the magnets (22) and the piston (39, 40) and are not located in intermediate space between the magnets and the piston.

It is respectfully submitted that a *prima facie* case of obviousness has not been made.

Under MPEP §2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted at least the third element of *prima facie* obviousness has not been established. Specifically, Bade does not disclose a shock-absorbing spacer element provided between the magnetic piston-retaining means and the drive piston.

Since all claims limitations must be considered in an obviousness determination, and since the combination of Bolte, Gschwend, and Bade fails to disclose several of the important and recited elements and features of independent claim 1, it is respectfully submitted the present invention, as defined by claim 1, is not rendered obvious by the combination of Bolte, Gschwend, and Bade and is, therefore, patentably defines over said combination.

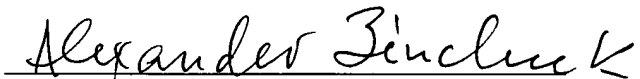
Accordingly, it is respectfully submitted that claim 1 is allowable. Claims 2 – 6 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

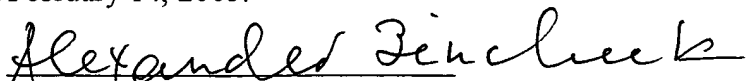


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I hereby certify that this corresponds is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 14, 2005.

Signature: 
Alexander Zinchuk